

ESTTA Tracking number: **ESTTA643984**Filing date: **12/11/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	DENT PERFECT, LLC d/b/a HAILUSA		
Entity	limited liability company	Citizenship	Missouri
Address	5337-E S. Campbell Avenue Springfield,, MO 65810 UNITED STATES		
Attorney information	Elliott J. Stein STEVENS & LEE, P.C. 100 Lenox Drive, Suite 200, Lawrenceville,, NJ 08648 UNITED STATES ejs@stevenslee.com, ddu@stevenslee.com Phone:609-987-7050		

Applicant Information

Application No	85864172	Publication date	11/18/2014
Opposition Filing Date	12/11/2014	Opposition Period Ends	12/18/2014
Applicant	www.freehailestimate.com, LLC 2835 East Division Ste. R Springfield, MO 65802 UNITED STATES		

Goods/Services Affected by Opposition

Class 037. First Use: 2009/08/00 First Use In Commerce: 2009/08/00
All goods and services in the class are opposed, namely: Automobile body repair and finishing for others

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Genericness	Trademark Act section 23
Other	res judicata and/or collateral estoppel

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FREE HAIL ESTIMATE or FREE HAIL ESTIMATES		
Goods/Services	vehicle repair services, specifically, paintless dent repair a/k/a paintless dent removal.		

Related Proceedings	Opposition No. 91-217750
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Attachments	HAILUSA-FreeHailEstimate-SECOND OPPOSITION-12112014.pdf(495898 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/varlawyer/
Name	Elliott J. Stein
Date	12/11/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Opposition No. _____

DENT PERFECT, L.L.C., a Missouri
limited liability company, also doing
business as HAILUSA,

Opposer

v.

www.freehailestimate.com, LLC, a Missouri
limited liability company,

Applicant.

U.S. Application Serial No. 85/864,172 for
“**1-877-774-HAIL FREE HAIL ESTIMATE**
.**COM AUTO HAIL ESTIMATING &**
REPAIR GROUP” & Design

Application published in the
in the Official Gazette: November 18, 2014

NOTICE OF OPPOSITION

Dent Perfect, L.L.C., a Missouri limited liability company also doing business as HAILUSA, (the “Opposer”) with principal offices at 5337-E S. Campbell Avenue, Springfield, Missouri, believes that it will be damaged if Trademark Application No. 85/864,172 (the “Latest Application”) for the trademark “**1-877-774-HAIL FREE HAIL ESTIMATE.COM AUTO HAIL ESTIMATING & REPAIR GROUP**” & Design (the “Latest Mark”) filed by www.freehailestimate.com, LLC, a Missouri limited liability company, (the “Applicant”) with an address of 2835 East Division, Suite R, Springfield, Missouri, is granted registration and so opposes the Application. Opposer further alleges, in support of its Opposition that:

BACKGROUND

1. Opposer and its predecessors have been in the paintless dent repair (“PDR”)¹ business since as early as 1991.

¹ Sometimes referred to as “paintless dent removal”.

2. Specifically, Opposer and other members of the PDR industry repair damage to motor vehicles and building structures caused by hail storms. They travel to affected cities in large, specially-equipped trailers and set up locations where those with vehicles and structures damaged by hail can get estimates on the cost of repair and obtain repairs.
3. Opposer and its predecessors have adopted and displayed trademarks comprised of and/or including the text string "FREE HAIL ESTIMATES" since at least 1991.
4. Opposer and its predecessors have used these trademarks continuously, and in interstate commerce, since that time.
5. On or about March 12, 2009, persons who would later be associated with the Applicant registered the uniform resource locator www.freehailestimate.com (the "Domain").
6. On March 20, 2009, the Applicant was chartered by the Missouri Secretary of State bearing the trade name www.freehailestimate.com, LLC.
7. On July 15, 2009, the Applicant filed its first application to register "FREEHAILESTIMATE.COM" and design. (Ser. No. 77/781,586; the "Early Application") specifying "Auto repair, namely, paintless dent repair." The trademark in the Early Application looked like this:

 **HailEstimate.com**

8. Even though, at the time of the Early Application, Applicant knew that Opposer had adopted and was using the trademark “FREE HAIL ESTIMATES”, Applicant falsely certified as part of the Early Application that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”
9. The Early Application was refused registration in at least three (3) Office Actions finding the trademark to be merely descriptive and taking note of the common use of the term “free estimate” by those engaged in repair services.
10. In a last ditch effort to obtain registration for “FREEHAILESTIMATE.COM” and design, Applicant falsely claimed that the trademark had acquired distinctiveness under Section 2(f) of the Trademark Act.
11. The Trademark Office then rejected Applicant’s claim to acquired distinctiveness and Applicant appealed to the Trademark Trial and Appeal Board (the “Board”).
12. On December 11, 2012, the Applicant’s Appeal was denied. The Board in its decision (the “Prior Decision”) held:

Accordingly, the mark FREEHAILESTIMATES.COM is merely descriptive of a significant feature of applicant’s paintless dent repair services for automobiles, namely indicating that the applicant provides, at no cost to the consumer, a statement of the expected cost of paintless dent repair of hail damaged vehicles.

13. The Board also held that the Applicant’s trademark was “highly descriptive” and had not gained acquired distinctiveness.

14. On December 27, 2012 – only days after the Board’s decision – the Applicant filed the two (2) new Applications for “FREEHAILESTIMATE.COM”. (The alleged trademarks which are the subject of the two (2) Applications are referred to herein as the “Later Marks.”)
15. The first of these was for the Word mark “FREEHAILESTIMATE.COM” – the very same text string that had been refused registration earlier. This application was assigned Serial No. 85/811,429 (the “429 Application”).
16. The second of the Applications was for “FREEHAILESTIMATE.COM” and design. This application was assigned Serial no. 85/811,436 (the “436 Application”) and looked like this:



17. The specification of services in both Applications is “Automobile body repair and finishing for others” rather than the “Auto repair, namely, paintless dent repair” set out in the Early Application even though the services offered by the Applicant were not changed.
18. Once again, and with full knowledge of Opposer’s adoption and continuous use of trademarks comprised of and/or including the text string “FREE HAIL ESTIMATES” in the very same PDR industry, Applicant falsely certified that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form

- thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”
19. On May 14, 2014, and after the Later Applications were twice rejected on the same bases as the Early Application had been by the Board, Applicant again claimed acquired distinctiveness for both trademarks.
 20. In support of the claim of acquired distinctiveness in both Applications, Applicant submitted false declarations dated May 14, 2014, claiming the Later Marks had become distinctive of the applicant’s services through the applicant’s substantially exclusive and continuous use [of the Later Marks] in commerce for at least the five years before the date of this statement.”
 21. In fact, the date of first use in commerce claimed in both of the application to register the Later Marks is June 10, 2009.
 22. When Applicant submitted those false declarations, Applicant knew of Opposer’s adoption and continuous use of trademarks comprised of and/or including the text string “FREE HAIL ESTIMATES”.
 23. When Applicant submitted those false declarations, Applicant knew that it had not used the Later Marks, “...for at least the five years before the date of [the] statement.”
 24. When it submitted those false declarations, Applicant knew that it had not used the graphic element disclosed in the ‘436 Application “...for at least the five years before the date of [the] statement.”
 25. The Applications for the Later Marks were published for opposition on July 15,

2014, and Opposer (on August 7, 2014) timely filed an Opposition to the applications to register both of the Later Marks. Those Oppositions were assigned Opposition No. 91-217750.

26. On March 1, 2013, the Applicant filed an application to register **"1-877-774-HAIL FREE HAIL ESTIMATE.COM AUTO HAIL ESTIMATING & REPAIR GROUP"** & design (the "Latest Mark"). The Applicant's Latest Mark looks like this:



27. Once again, and with full knowledge of Opposer's adoption and continuous use of trademarks comprised of and/or including the text string "FREE HAIL ESTIMATE" in the very same PDR industry, Applicant falsely certified that "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."

28. The application was assigned Serial No. 85/864,172 (the "Latest Application").

29. On April 22, 2013, the Trademark Office refused registration of the Latest Mark.

30. On May 21, 2013, the Trademark required that the Applicant disclaim each of “1-877-774-HAIL” “FREEHAILESTIMATE.COM” and “AUTO HAIL ESTIMATING & REPAIR GROUP” (the “Disclaimed Material”) and the Applicant subsequently agreed.
31. On October 18, 2013, the Applicant offered in support of the Latest Application, many arguments that were already rejected in the Prior Decision.
32. On November 14, 2013, the Trademark again rejected the Latest Application and the Applicant responded by characterizing its mark as “product packaging” rather than trade dress as asserted by the Trademark Office.
33. The Applicant also falsely alleged that the Latest Mark had “acquired distinctiveness based on Applicant's extensive use of its mark” and because “it uses the mark on all of its trailers, and it has dispatched those trailers to individual locations throughout the United States. In fact, the Latest Mark has not acquired distinctiveness.
34. The Latest Mark does not and cannot serve as an indicator of source because it is generic or highly descriptive.
35. Applicant has attempted the unambiguous determination of the Board in the Prior Decision.
36. Applicant is seeking registration of the Latest Mark specifically to damage the Opposer and other members of the PDR industry.

COUNT I: THERE IS A LIKELIHOOD OF CONFUSION

37. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1

- through 36.
38. The services offered by Opposer using trademarks consisting of or containing “FREE HAIL ESTIMATES” and the services offered by Applicant using the Latest Mark are very similar.
39. Allowing the Applicant to register the Latest Mark would damage Opposer by interfering with Opposer’s right to use trademarks consisting of or containing “FREE HAIL ESTIMATES” in connection with its services.
40. The Latest Mark is confusingly similar to Opposer’s trademarks consisting of or containing “FREE HAIL ESTIMATES” and Applicant’s registration and use thereof is likely to cause confusion, cause mistake and/or deceive the public as to the source and quality of Applicant’s services.
41. The Latest Mark is confusingly similar to Opposer’s trademarks consisting of or containing “FREE HAIL ESTIMATES” and Applicant’s registration and use thereof is likely to cause the public to believe, incorrectly, that Applicant’s services emanate from, are authorized or endorsed by, or are otherwise connected with Opposer.
42. The Latest Mark is confusingly similar to Opposer’s trademarks consisting of or containing “FREE HAIL ESTIMATES” and Applicant’s registration and use thereof would be violative of Section 2(d) of the Lanham Act.
43. The Latest Mark is not, therefore, eligible for registration by Applicant.

COUNT II: THE LATEST MARK IS GENERIC OR HIGHLY DESCRIPTIVE

44. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1

through 43.

45. The Latest Mark is generic in that it is comprised of words and combinations of words that are generic of the services offered by Applicant.
46. The Latest Mark is highly descriptive in that it merely conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used.
47. The Latest Mark has not acquired – and by its very nature cannot acquire – the distinctiveness for Applicant required to overcome the descriptiveness of the claimed trademark.
48. The false declaration submitted by Applicant does not and cannot support registration based upon use or passage of time, particularly, when the claimed trademarks have been in wide and continuous use by Opposer in commerce.
49. The Latest Mark is not, therefore, eligible for registration by Applicant.

**COUNT III: THE LATEST MARK CANNOT SERVE AS
AN INDICATOR OF THE SOURCE OF APPLICANT'S SERVICES**

50. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 through 49.
51. The Latest Mark is not a trademark or service mark in that it does not and cannot serve as an indicator of the source of Applicant's services.
52. The Latest Mark is not, therefore, eligible for registration by Applicant.

**COUNT IV: THE BOARD'S OPINION REGARDING THE EARLY
APPLICATION REQUIRES A REFUSAL TO REGISTER THE LATEST MARK**

53. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 through 52.
54. The Board, in the Prior Decision, ruled that the Latest Mark (apart from the Disclaimed Material) was highly descriptive.
55. The Board, in the Prior Decision, ruled that the Latest Mark (apart from the Disclaimed Material) had not acquired distinctiveness.
56. The Latest Application is not materially different from the Early Application.
57. Applicant's services offered under the Latest Mark is not materially different from those offered under the claimed trademark in the Early Application.
58. Applicant cannot avoid the effect of the Prior Decision by repeatedly resubmitting its failed applications.
59. The Latest Mark is not, therefore, eligible for registration by Applicant.

**COUNT V: APPLICANT HAS ENGAGED IN FRAUD IN FILING
AND PROSECUTING THE APPLICATIONS**

60. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 through 59.
61. Applicant misrepresented (under oath) material facts concerning Applicant's "substantially exclusive use" of the Latest Mark.
62. Applicant misrepresented (under oath) that the Latest Mark had acquired distinctiveness.

63. Applicant knew that these misrepresentations were false when it made them.
64. Applicant intended that the Trademark Office would rely upon these misrepresentations in its consideration of the Latest Application.
65. The Trademark Office did rely upon Applicant's misrepresentations in considering and approving the Latest Application for publication.
66. Opposer has been damaged by Applicant's actions in that the Trademark Office approved the Latest Application for publication based upon these misrepresentations and has been required to file this proceeding to ensure its continued right to use "FREE HAIL ESTIMATES".
67. Applicant should be denied registration for the Latest Mark as a result of its conduct.

WHEREFORE, Opposer prays that the Latest Application be denied and that APPLICANT's request for registration of the trademark "**1-877-774-HAIL FREE HAIL ESTIMATE.COM AUTO HAIL ESTIMATING & REPAIR GROUP**" & Design be denied and refused registration.

Dated: 11 December 2014

Respectfully submitted
STEVENS & LEE, P.C.



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Attorneys for Opposer

Dent Perfect, L.L.C. also doing business as
HAILUSA

CERTIFICATE OF SERVICE

I, Elliott J. Stein, certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION, was served on December 11, 2014 via U.S. regular mail, postage prepaid, upon the following counsel of record:

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Elliott J. Stein